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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/659,583

09/11/2000

Hideo Ando

04329.2385

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22852

7590

06/24/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

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EXAMINER

CHEVALIER, ROBERT

ART UNIT

PAPER NUMBER

2615

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DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/659,583

Applicant(s)

ANDO ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, and 13-17, drawn to an information storage medium having a recording region of audio and image information with the feature of the “display mode information indicating a display mode of the image information being described in the management information recorded at a head position in the first playback unit”, classified in class 386, subclass 96.
 - II. Claim 6, drawn to a method of playing back information from a medium including the feature of “only contents of the management information recorded at a head position in the first playback unit are used as valid information, and the image information is played back by accessing the image information based on the contents of the valid management information”, classified in class 386, subclass 75.
 - III. Claims 7-8, drawn to a method of playing back information from a medium including the feature of “when the management information of the first music number before divided has a pointer including display mode information indicating a display method of the image information.....to management of the divided second music number and management information of the divided third music number”, classified in class 386, subclass 54.

- IV. Claim 9, drawn to a method of playing back information from a medium including the feature of "all kinds of information that pertain to the audio information and the text information in the preceding.....at least one of audio information and the text information is played back on the transplanted information", classified in class 386, subclass 96.
 - V. Claims 10-11, drawn to a method of playing back information from a medium including the feature of "when management information of the first music number before combined with the second music number has a pointer including.....the first music number is provided to management information of the combined third music number", classified in class 386, subclass 54.
 - VI. Claim 12, drawn to a method of playing back information from a medium including the feature of "when the play list is selected or a predetermined first playback unit.....the specified image information which is allowed to be used is played back as the jacket image upon playing back the specified first playback unit", classified in class 386, subclass 55.
2. The inventions are distinct, each from the other because of the following reasons:
- The six groups of inventions are useable apart from each other and have unique specific structures not required of the other, and can therefore be separately useable as distinct inventions. For example the information storage medium having a recording region of audio and image information with the feature of the "display mode information indicating a display mode of the image information being described in

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the management information recorded at a head position in the first playback unit”, as recited in claim 1 of Group I, does not require the feature of “only contents of the management information recorded at a head position in the first playback unit are used as valid information, and the image information is played back by accessing the image information based on the contents of the valid management information” as specified in claim 6 of Group II, the feature of “when the management information of the first music number before divided has a pointer including display mode information indicating a display method of the image information.....to management of the divided second music number and management information of the divided third music number” as specified in claim 7 of Group III, the feature of “all kinds of information that pertain to the audio information and the text information in the preceding.....at least one of audio information and the text information is played back on the transplanted information” as specified in claim 9 of Group IV, the feature of “when management information of the first music number before combined with the second music number has a pointer including.....the first music number is provided to management information of the combined third music number”, as specified in claim 10 of Group V, and the feature of “when the play list is selected or a predetermined first playback unit.....the specified image information which is allowed to be used is played back as the jacket image upon playing back the specified first playback unit” as specified in claim 12 of Group VI.

Moreover, the method of playing back information from a medium including the feature of “only contents of the management information recorded at a head position in the first playback unit are used as valid information, and the image information is played

back by accessing the image information based on the contents of the valid management information” as specified in claim 6 of Group II does not require the feature of “display mode information indicating a display mode of the image information being described in the management information recorded at a head position in the first playback unit” as specified in claim 1 of Group I, the feature of “when the management information of the first music number before divided has a pointer including display mode information indicating a display method of the image information.....to management of the divided second music number and management information of the divided third music number” as specified in claim 7 of Group III, the feature of “all kinds of information that pertain to the audio information and the text information in the preceding.....at least one of audio information and the text information is played back on the transplanted information” as specified in claim 9 of Group IV, the feature of “when management information of the first music number before combined with the second music number has a pointer including.....the first music number is provided to management information of the combined third music number”, as specified in claim 10 of Group V, and the feature of “when the play list is selected or a predetermined first playback unit.....the specified image information which is allowed to be used is played back as the jacket image upon playing back the specified first playback unit” as specified in claim 12 of Group VI.

Moreover, the method of playing back information from a medium including the feature of “when the management information of the first music number before divided has a pointer including display mode information indicating a display method of the

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image information.....to management of the divided second music number and management information of the divided third music number” as specified in claim 7 of Group III does not require the feature of the “display mode information indicating a display mode of the image information being described in the management information recorded at a head position in the first playback unit”, as recited in claim 1 of Group I, the feature of “only contents of the management information recorded at a head position in the first playback unit are used as valid information, and the image information is played back by accessing the image information based on the contents of the valid management information” as specified in claim 6 of Group II, the feature of “all kinds of information that pertain to the audio information and the text information in the preceding.....at least one of audio information and the text information is played back on the transplanted information” as specified in claim 9 of Group IV, the feature of “when management information of the first music number before combined with the second music number has a pointer including.....the first music number is provided to management information of the combined third music number”, as specified in claim 10 of Group V, and the feature of “when the play list is selected or a predetermined first playback unit.....the specified image information which is allowed to be used is played back as the jacket image upon playing back the specified first playback unit” as specified in claim 12 of Group VI.

Furthermore, the method of playing back information from a medium including the feature of “all kinds of information that pertain to the audio information and the text information in the preceding.....at least one of audio information and the text information

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is played back on the transplanted information” as specified in claim 9 of Group IV does not require the feature of the “display mode information indicating a display mode of the image information being described in the management information recorded at a head position in the first playback unit”, as recited in claim 1 of Group I, does not require the feature of “only contents of the management information recorded at a head position in the first playback unit are used as valid information, and the image information is played back by accessing the image information based on the contents of the valid management information” as specified in claim 6 of Group II, the feature of “when the management information of the first music number before divided has a pointer including display mode information indicating a display method of the image information.....to management of the divided second music number and management information of the divided third music number” as specified in claim 7 of Group III, the feature of “when management information of the first music number before combined with the second music number has a pointer including.....the first music number is provided to management information of the combined third music number”, as specified in claim 10 of Group V, and the feature of “when the play list is selected or a predetermined first playback unit.....the specified image information which is allowed to be used is played back as the jacket image upon playing back the specified first playback unit” as specified in claim 12 of Group VI.

Furthermore, the method of playing back information from a medium including the feature of “when management information of the first music number before combined with the second music number has a pointer including.....the first music

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number is provided to management information of the combined third music number” as specified in claim 10 of Group V, does not require the feature of “the feature of the “display mode information indicating a display mode of the image information being described in the management information recorded at a head position in the first playback unit”, as recited in claim 1 of Group I, does not require the feature of “only contents of the management information recorded at a head position in the first playback unit are used as valid information, and the image information is played back by accessing the image information based on the contents of the valid management information” as specified in claim 6 of Group II, the feature of “when the management information of the first music number before divided has a pointer including display mode information indicating a display method of the image information.....to management of the divided second music number and management information of the divided third music number” as specified in claim 7 of Group III, the feature of “all kinds of information that pertain to the audio information and the text information in the preceding.....at least one of audio information and the text information is played back on the transplanted information” as specified in claim 9 of Group IV, and the feature of “when the play list is selected or a predetermined first playback unit.....the specified image information which is allowed to be used is played back as the jacket image upon playing back the specified first playback unit” as specified in claim 12 of Group VI.

Furthermore, the method of playing back information from a medium including the feature of “when the play list is selected or a predetermined first playback unit.....the specified image information which is allowed to be used is played back as

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the jacket image upon playing back the specified first playback unit” as specified in claim 12 of Group VI, does not require the feature of the “display mode information indicating a display mode of the image information being described in the management information recorded at a head position in the first playback unit”, as recited in claim 1 of Group I, does not require the feature of “only contents of the management information recorded at a head position in the first playback unit are used as valid information, and the image information is played back by accessing the image information based on the contents of the valid management information” as specified in claim 6 of Group II, the feature of “when the management information of the first music number before divided has a pointer including display mode information indicating a display method of the image information.....to management of the divided second music number and management information of the divided third music number” as specified in claim 7 of Group III, the feature of “all kinds of information that pertain to the audio information and the text information in the preceding.....at least one of audio information and the text information is played back on the transplanted information” as specified in claim 9 of Group IV, and the feature of “when management information of the first music number before combined with the second music number has a pointer including.....the first music number is provided to management information of the combined third music number”, as specified in claim 10 of Group V.

3. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for the other, and have acquired a separate status in the art and because of their recognized divergent subject matter

restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
June 22, 2004.


ROBERT CHEVALIER
PRIMARY EXAMINER